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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/886,350 | 06/21/2001 | Takanori Nishio | 16869P022900 | 4465 |

20350 7590 08/16/2004

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| EXAMINER |
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ELISCA, PIERRE E

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| ART UNIT | PAPER NUMBER |
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3621

DATE MAILED: 08/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/886,350

Applicant(s)

NISHIO ET AL.

Examiner

Pierre E. Elisca

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M6J

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 May 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office action is in response to Applicant's amendment, filed on 5/17/2004.
2. Claims 1-28 are pending.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-8, and 20-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Donovan et al. (U.S. Pat. No. 6,012,032) in view of Misra et al. (U.S. Pat. No. 6,189,146).

As per claims 1-6, and 20-28 Donovan substantially discloses a system/method of accounting and billing for data storage on a plurality of data storage devices. The data storage is mapped to a number of service levels, which specify varying data access and retrieval speeds (which is readable as Applicant's claimed invention wherein said a method for providing a plurality of service functions to a plurality of users by a storage system), comprising:

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receiving a request by a user of said plurality of users for performance of a service function of said plurality of service functions (see., abstract, col 2, lines 1-14, lines 46-67). It is to be noted that Donovan fails to explicitly disclose the step of checking if said service function is allowed by said storage system according to a usage constraint (usage constraint or license). However, Misra discloses a software licensing system that includes a license generator located at a licensing clearinghouse and at least one license server. The software license also has a license ID that is associated with the client or user ID in a database or storage record kept at the license server (see., abstract, col 2, lines 22-67, col 4, lines 1-67). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the data storage of Donovan by including the limitation detailed above as taught by Misra because this would assure that the terms are being met and assist the licensee with monitoring whether it is in compliance with software license.

As per claims 7 and 8 Donovan substantially discloses a system/method of accounting and billing for data storage on a plurality of data storage devices. The data storage is mapped to a number of service levels, which specify varying data access and retrieval speeds (which is readable as Applicant's claimed invention wherein said a method for providing a plurality of service functions to a plurality of users by a storage system), comprising:

receiving a request by a user of said plurality of users for performance of a service function of said plurality of service functions (see., abstract, col 2, lines 1-14, lines 46-

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67). It is to be noted that Donovan fails to explicitly disclose the step of checking if said service function is allowed by said storage system according to a usage constraint (usage constraint or license), said function being allowed if the storage area needed by said service function is under a preset value specified by the usage constraint.

However, Misra discloses a software licensing system that includes a license generator located at a licensing clearinghouse and at least one license server. The software license also has a license ID that is associated with the client or user ID in a database or storage record kept at the license server (see., abstract, col 2, lines 22-67, col 4, lines 1-67, please note that the license ID is readable as the preset value specified by the usage constraint or license). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the data storage of Donovan by including the limitation detailed above as taught by Misra because this would assure that the terms are being met and assist the licensee with monitoring whether it is in compliance with software license.

5. Claims 9-19 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Donovan in view of Glassman et al. (U.S. Pat. No. 6,453,305).

As per claims 9-19, Donovan substantially discloses a system/method of accounting and billing for data storage on a plurality of data storage devices. The data storage is mapped to a number of service levels, which specify varying data access and retrieval speeds (which is readable as Applicant's claimed invention wherein said a method for

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providing a plurality of service functions to a plurality of users by a storage system), comprising:

receiving a request by a user of said plurality of users for performance of a service function of said plurality of service functions (see., abstract, col 2, lines 1-14, lines 46-67). It is to be noted that Donovan fails to explicitly disclose the process of predetermining limit on a number of said plurality of users. However, Glassman discloses an electronic commerce system/method that enforces a license agreement for content on an open network by restricting the number of consumers or users that can concurrently access the content see., abstract, col 3, lines 43-67, col 4, lines 1-15. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the data storage of Donovan by including the limitation detailed above as taught by Glassman because this would restrict the number of consumers or users that access the content.

RESPONSE TO ARGUMENTS

6. Applicant's arguments filed on 5/17/2004 have been fully considered but they are not persuasive.

REMARKS

7. In response to Applicant's arguments, Applicant argues that the prior art of record (Donovan, Misra, and Glassman) taken alone or in combination fail to disclose:

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a. a usage constraint that comprises a storage area needed by the service function, wherein the service function is allowed if the storage area needed by the service function is under a preset value specified by the usage constraint. Based upon the foregoing rejection indicated above, it is believed that Misra discloses this limitation in col 2, lines 22-67, col 4, lines 1-67. Please note that the license ID is readable as the preset value specified by the usage constraint or license, and storage area is readable as a master license database that kept at the licensing clearinghouse.

b. paying a given price for a selected limitation. However, the Examiner disagrees since Glassman discloses this limitation in col 2, lines 46-52, col 3, lines 63-67, col 4, lines 1-6.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pierre E. Elisca whose telephone number is 703 305-3987. The examiner can normally be reached on 6:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703 305-9769. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Pierre Eddy Elisca

Primary patent examiner

August 11, 2004